

discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”¹⁷ Thus, even if the Examiner makes out a *prima facie* case of obviousness, Appellants may rebut this presumption by showing that the prior art teaches away from the claimed invention.¹⁸

Application of Law to the Facts #1 – Claims 33-37, 42, 45, and 67

Claims 33-37, 42, 44-49 and 64-70 stand rejected as being allegedly obvious over Guyett in view of McIntyre. This ground of rejection should be reversed, most notably because the rationale upon which the rejection is premised does not meet the statutory and judicial threshold for showing a *prima facie* case of obviousness. Appellants also contest this ground of rejection because McIntyre teaches away from the aspects cited in Guyett, thereby refuting the assertions of the Examiner that the references are properly combinable.

Claims 33 and 67 require the following three steps (in addition to the other steps recited in each respective claim):

- gathering data associated with the consumer’s interactions with the present interactive advertising message/computerized game;
- generating a statistical report from the data; and
- providing the statistical report to the commercial entity.

On page 7 of the final Office action it is admitted by the Examiner that Guyett does not specify generating a statistical report and sending it to the commercial entity as recited by claims 33 and 67. Nevertheless, the final Office action argues that McIntyre “teaches a statistical report that keeps track of how many times a game is played and the sending of this report to sponsors of the game (Paragraph 0008).”¹⁹ This interpretation of McIntyre is in err.

McIntyre discloses a computer game where advertising images of various sponsors are included in the game, where the game system keeps track of the use of the

¹⁷ *In re Kahn*, 441 F.3d 977, 990, 78 U.S.P.Q.2d 1329, 1338 (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)) (internal quotation marks omitted).

¹⁸ *In re Geisler*, 116 F.3d 1465, 1471, 43 U.S.P.Q.2d 1362, 1364 (Fed. Cir. 1997).

¹⁹ September 6, 2006 Office action, p. 7.